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Date: 26-JAN-2004

By:

(DANIEL L. MICHALEK)

PATENT

Attorney's Docket No. PHA-23.681



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

ONDECK

Application No.: 09/349,676

Filed: 07/08/1999

For: POST-SALES CUSTOMIZATION  
ACCORDING TO RETAILER'S  
SPECIFICATIONS

Group Art Unit: 3622

Examiner: Janvier, J.

Appeal No. \_\_\_\_\_

**RECEIVED**

FEB - 6 2004

**GROUP 3600**

BRIEF FOR APPELLANT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated 08/18/2003, finally rejecting claims 10-24, which are reproduced as an Appendix to this brief.

The Commissioner is authorized to charge the fee of \$330, and any other fees that may be required by this paper, to Deposit Account No. 14-1270.

**(1) Real Party in Interest**

The real party in interest is the assignee, Philips Electronic North America Corporation.

**(2) Related Appeals or Interferences**

Applicant is not aware of any related appeals or interferences.

**(3) Status of Claims**

Claims 10-24 remain pending in the present application. All claims have been finally rejected and all claims are on appeal.

**(4) Status of Amendments**

An amendment after final has been submitted. Per the Advisory Action of 11/03/2003, this amendment should have already been entered in connection with the present appeal.

**(5) Summary of the Invention**

As the title suggests, the present invention relates to post-sales customization of a product according to a retailer's specification. Such customization promotes loyalty between the owner of the product and the retailer. Such customization also stimulates sales of the product by the retailer, thereby also benefiting the product manufacturer. The invention is especially applicable to Internet-enabled and/or after-market upgradeable electronic devices or software applications.

The product may be a set-top box, for example, that is Internet-enabled and that accesses a particular home page. During electronic registration of the product, the product retailer is identified. As a result, the product is then customized, for example by causing an advertisement for the retailer to be displayed as part of the home page.

#### **(6) The References**

The rejection is based on Scroggie (WO 97/23838) and Goldman (Goldman et al., U.S. Patent 6,473,099).

Scroggie relates to an Internet-based system for distributing coupons or similar customer incentives. Supermarkets make wide use of such customer incentives. Just as paper coupons are often retailer-specific, so also in Scroggie the customer incentives are retailer-specific.

Goldman relates to software update of a set-top box.

#### **(7) The Rejection**

In the Final Rejection of 08/18/2003, claims 10-24 were rejected under 35 U.S.C. §103 as being anticipated unpatentable over Scroggie in view of Goldman. The rejection is quite discursive and rather opaque in its logic. However, the rejection does state in part:

Scroggie does not necessarily disclose the steps of registering by the customer the at least one product or base product sold by the identified retailer and storing customization information in the base product or the at least one product sold.

In other words, Scroggie does not teach or suggest the salient features of the present invention.

**(8) Issue**

The sole issue presented is whether claims 10-24 would have been obvious in view of Scroggie in combination with Goldman.

For purposes of the present appeal only, all claims may be considered to stand or fall with independent claim 10.

**(9) Argument**

As noted previously, the Final Rejection acknowledges that the primary reference, Scroggie, does not teach or suggest the salient features of the present invention.

The secondary reference, Goldman, does nothing to remedy the deficiencies of Scroggie. In fact, Applicant fails to appreciate the relevance of Goldman to either Scroggie or the present invention. Nothing in Goldman is retailer-focused or retailer-specific. Hence, although the system of Goldman may in some sense be well-adapted for realizing the present invention, Goldman does nothing to teach or suggest the present invention.


Furthermore, it would not have been obvious to one of ordinary skill in the art to combine the teaches of the references. Any motivation to do so is conspicuously lacking from the references themselves. The commonality of the Internet is not sufficient by itself to motivate combination of the teachings of the references.

**(10) CONCLUSION**

For the foregoing reasons, claims 10-24 would not have been obvious in view of Scroggie in combination with Goldman.

Applicant respectfully submits therefore that the Final Rejection should be REVERSED.

Respectfully submitted,

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Date: January 22, 2004

## APPENDIX OF CLAIMS

10. A method of converting a base product into a retailer-specific product, comprising:

    providing at least one base product to each of a plurality of retailers, each retailer having identifying information;

    electronically receiving registration information from a purchaser of at least one base product, the registration information including identifying information of the retailer from which the at least one base product was purchased; and

    electronically transmitting customization information, the customization information based, at least in part, on the identifying information of the retailer from which the at least one base product was purchased;

    wherein the base product is operable to receive and store said customization information.

11. The method of claim 10, wherein the base product is an electronic device having upgradeable software.

12. The method of claim 11, wherein the base product comprises an electronic device selected from the group consisting of a remote control, a personal, digital assistant, a television receiver, and a radio.

13. The method of claim 10, further comprising transmitting instructions for downloading of customization information.

14. The method of claim 13, wherein the customization information comprises a software application.

15. The method of claim 13, wherein the customization information comprises content information.

16. The method of claim 11, wherein the customization information is transmitted to a personal computer for subsequent communication to the base product.

17. The method of claim 11, wherein the customization information is transmitted to the base product.

18. The method of claim 11, further comprising providing advertising space for the retailer, from which the at least one base product was purchased, on at least one web page.

19. The method of claim 18, further comprising providing a portal for access by a purchaser of the base product.

20. A method of converting a base product into a modified base product, comprising:

    providing at least one base product to each of a plurality of entities, each entity having identifying information;

    electronically receiving registration information, the registration information including identifying information of the entity from which the at least one base product was obtained; and

    electronically transmitting customization information to the at least one base product, the customization information based, at least in part, on the identifying information of the entity from which the at least one base product was obtained;

wherein the base product is operable to receive and store said customization information.

21. The method of claim 20, wherein the entity is a retailer, the base product is an electronic device having upgradeable software, and further comprising transmitting instructions for downloading of customization information.

22. The method of claim 21, wherein the base product is obtained by purchase.

23. The method of claim 21, wherein the base product is obtained by lease.

24. The method of claim 21, further comprising providing advertising space for the retailer, from which the at least one base product was obtained, on at least one web page.